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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/528,471      | 03/21/2005  | Steven Joseph Wantling | B22-2523            | 4382             |

33349 7590 09/23/2009  
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| EXAMINER |
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CORDRAY, DENNIS R

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| ART UNIT | PAPER NUMBER |
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1791

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09/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/528,471

**Applicant(s)**

WANTLING ET AL.

**Examiner**

DENNIS CORDRAY

**Art Unit**

1791

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/15/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-44 is/are pending in the application.
- 4a) Of the above claim(s) 20-25 and 28-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,12-19,26 and 27 is/are rejected.
- 7) ☒ Claim(s) 5-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Oath/Declaration***

The Declaration of Steven J. Wantling, filed 6/15/2009, has been fully considered but is not complete and is not persuasive.

It is not clear if the Declaration is being filed under 37 C.F.R. 1.131 or 37 C.F.R. 1.132. Because the Declaration appears to be an attempt to antedate a cited prior art reference, it is discussed herein as if filed under 37 C.F.R. 1.131. The Declaration is incomplete because it fails to establish whether the laboratory data presented as evidence were gathered in the U.S., or a NAFTA or WTO member country, as required by 37 C.F.R. 1.131. Furthermore, the Declaration is made by one inventor rather than by both inventors of the claimed subject matter.

The Declaration presents pages from the declarant's laboratory notebook demonstrating the use of the claimed polymerized methylene coupled phenol with some of the other additives in the claimed composition from dates as early as November, 2001, which is prior to the filing date of cited U.S. patent 7294189. However, the composition of the emulsions recorded in the notebook fail to comprise all of the claimed components. The recorded composition is a mixture of one or more waxes, an alkyl phenol, water, one or more starches, borax, sodium lignate and KOH. In some compositions, Metasol, Metasol D3TA, c-150 or Disal was added. No compositions containing the claimed polynaphthalenesulfonic acid were recorded. The laboratory data thus fails to demonstrate that the claimed composition was made prior to the above cited reference. It is also noted that the submitted pages were signed by the other

inventor in the current application rather than by the declarant.

### ***Response to Arguments***

Applicant's filing of a statement of common ownership has overcome the following rejections:

Claims 5-11 under 35 U.S.C. 103(a) over Wantling '189 in view of Song (6010596) and Wantling (6165261);

Claims 1, 2, 4, 12-14 and 26 under 35 U.S.C. 103(a) over Imai (5120355) in view of Manka et al (7026378);

Claims 5-11 under 35 U.S.C. 103(a) over Imai in view of Manka et al and further in view of Song (6010596) and Wantling (6165261).

The indicated rejections have been withdrawn.

The rejection of Claims 1, 2, 4, 12-19, 26 and 27 under 35 U.S.C. 102(e) as being anticipated by Wantling (7294189) is maintained, as well as the Double Patenting rejections.

### ***Claim Objections***

Claim 11 is objected to because of the following informalities: the word "tile" should be changed to "the". Appropriate correction is required

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 4, 12-19, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Wantling (7294189).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference (Oct. 11, 2002), it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Wantling discloses an emulsion comprising water, wax and a preservative (Abs, col 4, lines 9-12). Note that the open claim language of the instant claims allows for additional components, such as the preservative. In some embodiments, the emulsion also comprises a complexed starch, the complexing agent being a borate or molybdenum compound; a wax having a melting point from 120 °F to 165 °F; a saponifiable wax; an alkali metal hydroxide such as sodium or potassium hydroxide; a polynaphthalenesulfonic acid; and an alkyl phenol such as a C<sub>24</sub> to C<sub>36</sub> polymerized methylene coupled alkyl phenol (col 7, lines 4-21 and 29-46; col 8, lines 4-9 and 27-34; col 9, lines 52-58). The starch can be an acid-modified starch (col 12, lines 19-32,

Table 3). The saponified wax can act as a surfactant (col 7, lines 29 and 30). Other surfactants can also be used in a dual surfactant system, such as an alkoxyated fatty acid ester (col 11, lines 18-35). Compositions having the claimed amounts of additives are disclosed (col 11, line 42 to col 12, line 32).

### ***Allowable Subject Matter***

Claims 5-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The nearest prior art, Wantling (7294189), teaches the claimed composition but fails to teach the claimed surfactants. None of the other cited art discloses or makes obvious the claimed composition. Wantling teaches that the combination of polymerized alkyl phenol and polynaphthalenesulfonic acid forms a detergent/dispersant, thus acts as a surfactant system. Additional surfactant systems include dodecylisopropanolamine benzene sulfonate and ethoxylated aryl phenol or a lignin sulfonate in combination with certain waxes. The disclosed surfactants are dissimilar to the claimed species. The Wantling reference is unavailable for use in an obviousness rejection, and claims 5-11 would not have been obvious to one of ordinary skill in the art at the time of the invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4, 12-19, 26 and 27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 21 of U.S. Patent No. 7473712 in view of Imai. The composition of the patent comprises the same ingredients as the claimed composition with the exceptions that the melting point of the first wax is not claimed and a surfactant is not claimed in the patent. Imai discloses waxes having the claimed melting point as suitable for such compositions. Surfactants are well known in the art as typical components in an emulsion and are also disclosed by Imai in similar compositions. One of ordinary skill in the art would have found it obvious to include the claimed waxes and surfactants in view of Imai.

Claims 1-4, 14-19 and 26-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8

and 17 of U.S. Patent No. 7473713 view of Imai. The composition of the patent comprises the same ingredients as the claimed composition with the exceptions that the melting point of the first wax is not claimed and a surfactant is not claimed in the patent. Imai discloses waxes having the claimed melting point as suitable for such compositions. Surfactants are well known in the art as typical components in an emulsion and are also disclosed by Imai in similar compositions. One of ordinary skill in the art would have found it obvious to include the claimed waxes and surfactants in view of Imai.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DENNIS CORDRAY whose telephone number is (571)272-8244. The examiner can normally be reached on M - F, 7:30 -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Cordray/  
Examiner, Art Unit 1791

/Eric Hug/  
Primary Examiner, Art Unit 1791